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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,505	03/08/2001	Seigo Kotani	1405.1036	2180
21171	7590	03/08/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			SIMITOSKI, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2134	4

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

**Office Action Summary**

Application No.

09/800,505

Applicant(s)

KOTANI ET AL.

Examiner

Michael J Simitoski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**NORMAN M. WRIGHT**  
**PRIMARY EXAMINER**

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The IDS of 3/8/01 has been received and considered.
2. Claims 1-26 are pending.

### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "apparatus [claimed as distinct from the recording medium] having (1) medium-specific information and comprising (2) a user-use area ... (3) and a secure area ... managing information of a recording medium ... " (claims 18-26) must be shown or the feature(s) canceled from the claim(s). Fig. 4 #41, Fig. 8 #51, Fig. 10 #61 & Fig. 13 #71 show an apparatus coupled to a *recording medium* having the above claimed features. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The disclosure is objected to because of the following informalities:

- a. On page 8, line 17, "," should be replaced with "and".
- b. On page 8, line 21, "," should be replaced with ",".

Appropriate correction is required.

#### ***Claim Objections***

6. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1 states that the predetermined information is encrypted using a medium-specific information or key generated therefrom and is stored in said predetermined area.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specifications teach a recording medium having medium-specific information, a user-use area and a secure area and an apparatus communicating (reading/writing) to/from the recording medium. The drawings appear to only illustrate the user-use area/secure area structure as it pertains to the storage medium. The specifications also refer to the medium-specific information existing on the storage medium, except for pages 8-9. However, the paragraphs on pages 8-9 are worded in a similar fashion to claim 18 and do not further clarify the claim enough to enable one of ordinary skill in the art to make or use the invention. Claims 19-26 are rejected because of their dependency on claim 18.

*For the purposes of this office action, claim 18 is understood to claim a recording medium having medium-specific information, a user-use area, a secure area not subject to control by external instructions wherein license information based on use rights are stored in the secure area, and an information management apparatus comprising write and read out means writing and reading to/from the user-use area and predetermined information deriving means encrypting predetermined information stored in the secure area using medium specific information.*

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- c. Claim 1 is directed toward an apparatus with particular features and lacks clear and distinct active method steps. Claims 2-17 are rejected because of their dependency on claim 1.
- d. Claim 2 recites the limitation "the information management system of claim 1" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claims 3-6 & 16 are rejected because of their dependency on claim 2.
- e. Claim 18 is vague and indefinite because it is unclear whether the limitations of the claim are referring to the apparatus, recording medium or a combination of both. The drawings appear to only illustrate the user-use area/secure area structure as it pertains to the storage medium. The specifications also refer to the medium-specific information existing on the storage medium, except for pages 8-9. However, the paragraphs on pages 8-9 are worded in a similar fashion to claim 18 and do not further clarify the claim. Claims 19-26 are rejected because of their dependency on claim 18.

*For the purposes of this office action, claim 18 is understood to claim a recording medium having medium-specific information, a user-use area, a secure area not subject to control by external instructions wherein license information based on use rights are stored in the secure area, and an information management apparatus comprising write and read out means writing and reading to/from the user-use area and predetermined information deriving means encrypting predetermined information stored in the secure area using medium specific information.*

f. Claim 19 recites the limitation "the encrypted license information" in line 2.

There is insufficient antecedent basis for this limitation in the claim. Claim 20 is rejected because of its dependency on claim 19.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2 & 11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,392,351 to Hasebe et al. (Hasebe).

Regarding claim 1, Hasebe discloses predetermined information/permission information (Fig. 2 #13) stored in a predetermined area (Fig. 2) of a recording medium/storage medium having medium-specific information/medium number (Fig. 2 #12) that is encrypted using said medium-specific information/medium number (Fig. 2 #12) or a key generated therefrom (Fig. 2 #21) and derived outside said predetermined area/user computer (Fig. 2).

Regarding claim 2, Hasebe discloses a first area storing said predetermined information/permission information and a second area different from said first area (Fig. 2 #13-14).

Regarding claim 11, Hasebe discloses said encrypted predetermined information/permission information stored on a second recording medium/permission

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information storage medium different from said recording medium/software storage medium  
(Fig. 13).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 3-7, 9, 13, 18, 19, 21, 23 & 25, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe in view of U.S. Patent Application Publication 2001/0042043 to Shear et al. (Shear).

Regarding claim 3, Hasebe discloses a system, as described above, with a user-user area (Fig. 2 #14 & Fig. 12) but lacks the first area being a secure area not subject to control by external instructions. However, Shear teaches that keys can be contained in a hidden area on a disc, not normally accessible so that an attempt to copy the disc would not copy the keys (page 15, ¶218). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to store the predetermined information in a secure area not subject to control by external instructions. One of ordinary skill in the art would have been motivated to perform such a modification to prevent copying of the predetermined information, as taught by Shear (page 15, ¶218).



Regarding claim 4, Hasebe, as modified above, discloses encrypted electronic data stored in the second area (Fig. 2 #14) and predetermined information/permissions information stored in the first area (col. 5 lines 31-39).

Regarding claim 5, Hasebe discloses predetermined information/permission information (Fig. 2 #13) stored in a predetermined area (Fig. 2) of a recording medium/storage medium having medium-specific information/medium number (Fig. 2 #12) that is encrypted using said medium-specific information/medium number (Fig. 2 #12) or a key generated therefrom (Fig. 2 #21).

Regarding claims 6 & 9, Hasebe discloses a system, as described above (Fig. 13 & col. 10 lines 50-59), but lacks encrypting the predetermined information/permission information with information specific to an apparatus that drives the second recording medium (or a key generated therefrom). However, Shear teaches using keys to protect 'metadata' that is used to determine access properties to 'property' on a storage medium (Fig. 3). The keys on the storage medium are encrypted with a key(s) specific to the apparatus so the keys in the encrypted key block are not exposed (Fig. 3 & page 15 ¶219). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the predetermined information with a key specific to the driving apparatus. One of ordinary skill in the art would have been motivated to perform such a modification to prevent keys/data from being exposed, as taught by Shear (Fig. 3 & page 15 ¶219).

Regarding claim 7, Hasebe discloses a system, as modified above, where the encrypted predetermined information/permission information is stored in said second area (Fig. 2).

Regarding claims 13, 21, 25 & 26, Hasebe discloses a system, as described above (Fig. 13 & col. 10 lines 50-59), but lacks further encrypting the predetermined information/permission information with information specific to an apparatus that drives the second recording medium (or a key generated therefrom). Regarding claim 26, Hasebe discloses a second recording medium (Fig. 13). However, Shear teaches using keys to protect 'metadata' that is used to determine access properties to 'property' on a storage medium (Fig. 3). The keys on the storage medium are encrypted with a key(s) specific to the apparatus so the keys in the encrypted key block are not exposed (Fig. 3 & page 15 ¶219). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further encrypt the predetermined information with a key specific to the driving apparatus. One of ordinary skill in the art would have been motivated to perform such a modification to prevent keys/data from being exposed, as taught by Shear (Fig. 3 & page 15 ¶219).

Regarding claim 18, as best understood, Hasebe discloses an apparatus/vendor computer (Fig. 2) with a stored medium with medium-specific information/medium number (Fig. 2 #12) and comprising a user-use area allowing reading out of information/permission information (Fig. 2), the apparatus/computer managing information of a recording medium wherein license information/permission information based on use rights for any information stored in a user-user area is stored in a secure area (Fig. 2) and write and read out means/vendor computer and user computer transferring information to and from a user-user area predetermined information deriving means/vendor computer for encrypting predetermined information/permission information (Fig. 7A) stored in the secure area with medium-specific/medium number information or a key generated therefrom and deriving the same outside the secure area (Fig. 2,

#13, 22 & 23). Hasebe further discloses reading/user computer and writing means/vendor computer (Fig. 2) to read and write to the user-use area and encrypting permission information with medium-specific information/medium number (Fig. 2 #12, 21, 23, 22 & 13). Hasebe lacks a secure area not subject to control by external instructions. However, Shear teaches that keys can be contained in a hidden area on a disc, not normally accessible so that an attempt to copy the disc would not copy the keys (page 15, ¶218). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include predetermined information deriving means encrypting predetermined information stored in a secure area not subject to control by external instructions. One of ordinary skill in the art would have been motivated to perform such a modification to prevent copying of the predetermined information, as taught by Shear (page 15, ¶218).

Regarding claim 19, Hasebe discloses storing encrypted license information/permission information in a user-use area (Fig. 2 # 13 & Fig. 12)

Regarding claim 23, Hasebe discloses transferring the license information stored in medium 1 to another user (col. 5 lines 3-16 & col. 11 lines 20-33). Hasebe does not explicitly disclose transferring to another medium (although it is implied in that licensing information is stored on a storage medium and therefore the transfer of licensing information to another user would imply transferring it to another medium), however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer the information to another storage medium. One of ordinary skill in the art would have been motivated to perform such a modification to transfer the information to another users storage medium to transfer privileges, as was well known in the art at the time the invention was made.

15. Claims 12 & 15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe in view of U.S. Patent 5,191,611 to Lang.

Regarding claim 12, Hasebe discloses a system, as described above, but lacks updating the predetermined information/permission information. However, Lang teaches that to authorize a user a specific number of information retrievals, a personal access device (PAD) can receive an update command reflecting the users' updated privileges (col. 12 lines 36-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the updating of the predetermined information. One of ordinary skill in the art would have been motivated to perform such a modification to limit data retrievals by users, as taught by Lang (col. 12 lines 36-58). Further, it is inherent, based on the key(s) used for encryption, that decryption will use the same key(s).

Regarding claim 15, Hasebe discloses a system, as described above, but lacks the medium-specific information/medium number being visually displayed on the recording medium. However, Lang teaches that by displaying information visually on a device for controlling access to data, a user can manually enter the data into another device (col. 6 lines 55-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to visually display the medium-specific information/medium number on the recording medium. One of ordinary skill in the art would have been motivated to perform such a modification to allow for manual entry of the medium-number into another device, as taught by Lang (col. 6 lines 55-59).

16. Claims 8, 10, 14, 16, 17, 20, 22 & 24, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe in view of Shear, as applied to claims 7 & 13 above, in further view of Lang.

Regarding claims 8, 10, 14, 17, 20, 22 & 24, Hasebe discloses a system, as modified above, but lacks updating the predetermined information/permission information. However, Lang teaches that to authorize a user a specific number of information retrievals, a personal access device (PAD) can receive an update command reflecting the users' updated privileges (col. 12 lines 36-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the updating of the predetermined information stored in the predetermined/first area or secure area. One of ordinary skill in the art would have been motivated to perform such a modification to limit data retrievals by users, as taught by Lang (col. 12 lines 36-58). Further, it is inherent, based on the key(s) used for encryption, that decryption will use the same key(s).

Regarding claims 16 & 17, Hasebe discloses a system, as modified above, but lacks the apparatus-specific information being visually displayed on the apparatus. However, Lang teaches that by displaying information/code visually on a device/smart card for controlling access to data, a user can manually enter the data into another device (for key generation and challenge-response identification) (col. 6 lines 55-59 & col. 7 lines 44-65). Lang further discloses electronic transmission from the smartcard to another device such as a reader (col. 12 lines 53-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to visually display the information specific to an apparatus on the apparatus. One of ordinary skill in the art would have been motivated to perform such a

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modification to allow for user access to the apparatus-specific information for entry into another device to derive a key or entertain challenge-response identification, as taught by Lang (col. 6 lines 55-59 & col. 7 lines 44-65).

### *Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

g. U.S. Patents 5,886,979 and 5,818,812 were cited for having a medium-specific code embedded on a storage medium.

h. "IBM Cryptolopes<sup>TM</sup>, SuperDistribution and Digital Rights Management" is relevant because it discusses packaging permissions/rights with the data to be accessed using those permissions on a medium.

i. The JPO references made of record teach similar techniques for copyright management as the instant applications, specifically using a medium-specific number and licensing information on a storage medium.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (703)305-8191. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. - 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703)308-4789.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, DC 20231

**Or faxed to:**

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(703)746-7239 (for formal communications intended for entry)

**Or:**

(703)746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

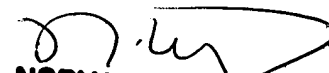
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJS  
March 2, 2004

  
**NORMAN M. WRIGHT**  
**PRIMARY EXAMINER**